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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TWAR.069A/TWC-IPV-03-10

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on June 16, 2010

Signature

Typed or printed name Robert F. Gazdzinski

Application Number

10/639,070

Filed

August 12, 2003

First Named Inventor

Steven E. Riedl

Art Unit

2423

Examiner

Bantamoi, Anthony

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record. 39,990  
Registration number 39,990

Signature

Robert F. Gazdzinski

Typed or printed name

858-675-1670

Telephone number

attorney or agent acting under 37 CFR 1.34.

June 16, 2010

Registration number if acting under 37 CFR 1.34

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.



\*Total of  forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

## **PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir or Madam:

In response to the Office Action dated March 16, 2010 (“Office Action”), Applicant herein requests a pre-appeal brief review of the above-identified application as follows:

**I. CLEAR ERROR IN ASSERTING KINDER TEACHES IN RESPONSE TO A DETECTION OF THE MESSAGE INDICATING A SCHEDULED PROGRAMMING SEGMENT FOR CLAIM 9**

On pages 4-5 of the Office Action in the remarks directed at Claim 9 the Examiner states that Hendricks (U.S. Patent No 6,46,585, hereinafter “Hendricks”) teaches:

*“detecting, in the program stream, a message indicating a scheduled programming segment (col. 30, II. 2-4 (the spot placement engine receives information about program break (event) wherein the received information about the program break meets “an indicator” because the information tells the spot placement engine... ”. {emphasis added}*

Further, on page 6 the Examiner states that Hendricks is silent:

“...on in response to a detection of the message, identifying a set of user terminals currently receiving the program stream; identifying one or more groups of user terminals within the set of user terminals currently receiving the program stream;...”.

However, on page 6 of the Office Action, the Examiner contends that Kinder (WO Patent Publication No. 2001/91474; hereinafter “Kinder”) teaches in response to a detection of the message, indicating a scheduled programming segment. Applicant respectfully disagrees, and point out that the Examiner is using two different interpretations of the term “message”.

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Specifically: (i) a message indicating a scheduled programming event (as in Hendricks); and (ii) the feedback tags - the tags indicate the current program a user is watching (as in Kinder).

Applicant asserts that the Examiner uses inconsistent interpretations of Applicant's claim terminology within the same claim, in violation of well established case law. See *inter alia*, 5 *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed. Cir. 2001) ("a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent"). The Examiner respectfully cannot adopt one interpretation of the same term in one place, and another interpretation in another place, to support his obviousness rejection.

Applicant further notes that MPEP 2111 sets forth that "[d]uring patent examination, the 10 pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969)." {emphasis added} The invention of 15 Claim 9 sets forth "a message indicating a scheduled programming segment." Kinder, however, merely describes periodic modifications of the schedule "based on feedback received from actual viewers" (page 7, lines 16-17). In other words, the invention of Claim 9 describes performing of certain steps (e.g., identifying a set of user terminals currently receiving the program stream), being performed in response to receiving an indication of a scheduled event (e.g., an advertising break) in the delivery of programming stream. This functionality is, respectfully, entirely 20 different from the teaching of Kinder, wherein certain steps are performed in response to received viewer data.

Applicant therefore concludes that the Examiner's rejection based on Kinder allegedly teaching "in response to a detection of the message, a indicating a scheduled programming segment" constitutes a clear and reversible error.

## 25 II. CLEAR ERROR IN FAILING TO SHOW PRIMA FACIE CASE OF OBVIOUSNESS FOR CLAIM 1

On page 3 of the Office Action, in the remarks directed at Claim 1, the Examiner concedes that Hendricks is silent on:

30 "…*in response to a detection of the indicator, generating a list of individual ones of the plurality of user terminals currently receiving the programming content; obtaining data descriptive of at least one group of members of the list; generating substantially in real-time at least one programming segment based at least on the data...*". {emphasis added}

35 Moreover, in the follow-up remarks directed at Kinder, the Examiner is silent with respect to whether Kinder teaches the in response to a detection of the indicator element of Claim 1.

40 Therefore the Examiner has respectfully failed to establish a *prima facie* case of obviousness for Claim 1, by not addressing all of the limitations of Claim 1.

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Furthermore, even assuming, *arguendo*, that the Examiner were to assert that Kinder teaches this limitation, Applicant contends that Kinder does not in any way teach or suggest functionality where the aforementioned generating is performed in response to a detection of the indicator (the indicator being indicative of an event in the delivery of the programming content).

5 Please refer to the remarks directed to Claim 9 *supra*.

Applicant therefore submits that the Examiner's failure to establish a *prima facie* case of obviousness for Claim 1 constitutes a clear and reversible error.

### 10 III. CLEAR ERROR IN ASSERTING HENDRICKS TEACHES DYNAMICALLY ASSIGNING TRANSMISSION CHANNELS

15 On pages 9-10 of the Office Action, in the remarks directed at Claims 36 and 68, the Examiner contends that Hendricks teaches "module for dynamically assigning transmission channels (figure 4c, label 305)". Applicant respectfully disagrees and notes that MPEP 2111 sets forth "[d]uring patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969)." {Emphasis added} The term "transmission channel" is explicitly defined at par. [0027] of U.S. Patent Publication No. 2005/0039205 as a physical channel, and not a logical programming channel:

20 "The term "transmission channel" used here should not be confused with "program channel." A "transmission channel" signifies a designated frequency band through which a stream containing program material is transmitted".

25 Hendricks, however, is completely silent with respect to the physical transmission channel, and instead defines the feeder channel as an alternate program channel ("Multiple channel architecture that includes a program channel and a number of feeder channels to carry alternate programming, such as alternate targeted advertisements".) See col. 4, lines 27-29 of Hendricks.

30 Applicant therefore submits that the Examiner's assertion that Hendricks teaches "module for dynamically assigning transmission channels" constitutes a clear and reversible error.

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#### IV. CONCLUSION

In summation, Applicant respectfully submits that the Examiner has committed clear and reversible error in at least those instances described above. Accordingly, Applicant requests that the Final Rejection for the above-identified case be withdrawn, and the case passed to allowance, or a subsequent Office communication correcting the above highlighted deficiencies issued.

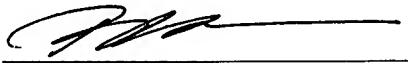
Respectfully submitted,

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GAZDZINSKI & ASSOCIATES, PC

Dated: June 16, 2010

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Dated: June 16, 2010

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